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EXAMINER

WORJLOH, JALATEE

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/683,942	Applicant(s) PARMELEE ET AL.	
	Examiner Jalatee Worjloh	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) 29-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed December 14, 2007. Claims 1-83 are pending.

Response to Arguments

2. Applicants' arguments filed December 14, 2007 have been fully considered but they are not persuasive.
3. Applicants' argue that the phrase "'operative to' grammatically limits the claim scope with respect to the subject matter associated with the phase".

However, the Examiner respectfully disagrees. It is known in the art that computers with at least a floppy drive, CD-R or DVD-R drive have the ability to store documents [with or without a signature]. Thus, any computer including at least a floppy drive, CD-R or DVD-R drive is operative to store any type of data including a digitally signed copy of an electronic document. "The recitation of a new intended use of an old product does not make a claim to that old product patentable". *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]" MPEP §2106 II C.

4. Applicant's arguments, see pages 30 and 31, filed December 14, 2007, with respect to 35 USC 112 rejection have been fully considered and are persuasive. The 35 USC 112 rejection has been withdrawn.

Examiner's Comments

5. Applicant describes the claimed apparatus using the terms “operative to [do something]”. However, this does not sufficiently differentiate the claims from the prior art. For Instance, claim 16 recites “a computer processor is operative to store a digitally signed copy of the electronic document on the portable storage medium”. However, to one of ordinary skill, all the prior art is required to show, for example, is computer with a floppy drive, CD-R or DVD-R drive, or a slot for receiving flash memory, as either of these embodiments is *operative to store* not only a signed electronic document, but any computer readable data.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1 and 28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7216083 to Parmelee et al.

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("Parmelee"). Although the conflicting claims are not identical, they are not patentably distinct from each other because Parmelee teaches the elements of claim 1 (see step (d)), but also discloses additional features (see steps (a) –(c)). However, it would have been obvious to a person of ordinary skill in the art to modify claim 1 of Parmelee by removing the additional limitations, resulting generally in the claims of the present application, since the claims of the present application and the claim recited in actually perform a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karison*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Thus, omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes, U.S. Patent No. 6,848,048.

As per claims 1-28, Holmes teaches an apparatus comprising:

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- an ATM, computer processor, an input device and a display device (column 2, lines 38-53; column 3, lines 7-14; column/line 3/38-4/14; column 4, lines 29-51; column 5, lines 38-65; column 6, 30-62)
- a cash dispenser, card reader (column 2, lines 43-45; column 4, lines 55-60)
- a computer processor causing an electronic document to be time-stamped (column 2, lines 38-53; column 3, lines 28-35; column/line 7/62-8/10) and retrieving a document from, and sending a document to, an external source (column 3, lines 5-35; column 7, lines 63-67; column 8, lines 3-5)
- a communication port connected to the computer processor (figure 2; column 3, lines 5-27; column 4, lines 41-43; column/line 7/62-8/10)
- signing a document with a private key (column/line 4/44-5/29; column 7, lines 45-53)
- storage device drive connected to the computer processor (figure 2; column 4, lines 28-38) and retrieving an electronic document from a portable storage medium (column 4, lines 28-36)
- storing a digitally signed copy of a document (column 4, lines 28-36)
- the computer processor communicating with a remote server (figure 2; (column 3, lines 5-35; column 7, lines 63-67; column 8, lines 3-5)
- retrieving a private key from a portable computing device (i.e. smart card) and signing the document using the obtained key (column 7, lines 45-50) and

generating a digital signature by the portable device (column 5, lines 10-21;
column 7, lines 48-50)

Applicant attempts to further limit the claimed display device by describing what is displayed. However, this is representative of non-functional descriptive material as the electronic document is not functionally related to the display device (MPEP 2106 II; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994)) and therefore cannot be used to differentiate Applicant's device from the prior art display device of Holmes (column 4, lines 38-43). Regarding, the process steps of digitally signing the electronic document (see also *IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)), this is functional language and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)), hence Holmes (figure 2) is sufficient in terms of prior art. Claims 2, 5, 9, 15, 17, 19, 20, 21, 23-25, 27 and 28 also express steps in terms of functional language.

As per claim 4, ATMs with signature pads are old and well known therefore, it would have been obvious to one of ordinary to use a signature pad or other input device to enter data into the ATM.

As per claim 6, claim 1, from which claim 6 depends, is directed to an apparatus. Claim 6 on the other hand, is directed to an account number. However, this is representative of non-functional descriptive material as the account number is not functionally related to the computer processor (MPEP 2106 II; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994)) and therefore cannot be used to differentiate Applicant's processor from the prior art processor of Holmes (figure 2; column 3, lines 43-63). Claims 8 (i.e. an ATM façade upon which data is printed) and 13 (i.e. words in the document) (see also column 3, lines 28-44 and column 5, lines 28-44 where Holmes describes creating a document) recite similar language

As per claims 11 and 12, the external source is not part of the apparatus of claim 1, and therefore cannot be relied upon to distinguish the claimed apparatus from the apparatus of Holmes (figure 2). Claim 17-28 recites similar language.

As per claim 19, it is rejected under 112 second paragraph for not clearly defining the claim as a method or an apparatus (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)). In addition, claim 19 recites language directed to processes performed by a server. However, as the server is not part of the apparatus described by claims 1, 3 or 17 it cannot be relied upon to distinguish the claimed apparatus from the apparatus of Holmes (figure 2). Therefore, as Holmes teaches a computer device for generating a hash function (column 2, lines 54-65; column 5, lines 10-15; column 7, lines 35-45), wherein the

computer is also operative to receive a digital signature and attach the signature to a document (column 2, lines 54-65; column 5, lines 32-44; column 7, lines 50-55; column 8, lines 17-45), Holmes is sufficient as prior art. Claims 23 and 27(column 5, lines 10-21; column 7, lines 48-50) are also rejected as each recites language similar to claim 19.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes, U.S. Patent No. 6,848,048 in view of Otway, U.S. Patent No. 6,192,130.

As per claim 20, Holmes teaches storing a private key on a computing device wherein the device uses the key to digitally sign a document (column 7, lines 44-46). However, Holmes does not specify how the computing device obtained the key. Otway teaches a remote server generating an encryption key

pair and transmitting a private key of the pair to a computing device (column/line 1/35-2/15). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Holmes and Otway in order to allow a user whose private key was compromised to obtain a new private key ('130, column 1, lines 35-67).

Conclusion

8. Functional recitation(s) using the word “operative to” or other functional language have been considered but are given little patentable weight¹ because they fail to add any structural

¹ See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that

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limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent NO. 5650605 to Morioka et al. discloses an automated transaction apparatus.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

although all limitations must be considered, not all limitations are entitled to patentable weight).

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/
Primary Examiner, Art Unit 3621